

REMARKS

1. Claims 2 and 4 fulfill the requirements of 35 U.S.C. §112.

Claims 2 and 4 stand rejected on 35 U.S.C. §112, first paragraph grounds for failing to satisfy the written description requirement. Applicants thank the Examiner for his helpful suggestions on claim amendments sufficient to overcome this ground of rejection. Having made the suggested amendments, Applicants respectfully submit that the amended claims overcome the asserted ground of rejection. Applicants therefore respectfully request the Examiner to withdraw this rejection.

Claims 2 and 4 are rejected on 35 U.S.C. §112, second paragraph grounds for being indefinite for reciting hybridization under "high stringency conditions." The Patent Office takes the position that the limitation is "conditional" and no explicit set of conditions are recited. Applicants respectfully contend that the term would be understood by one having ordinary skill in the art, the standard for statutory definiteness, as evidenced by several contemporary reference books in the art (such as the Maniatis cloning manual). Applicants further contend that, although stringency conditions less than high stringency may be indefinite, high stringency is neither conditional or undefined. Applicants would be willing to incorporate this well-known understanding of the term "high stringency" into the claim if the Examiner indicates that such explicit a recitation is required and sufficient to overcome the rejection. However, Applicants respectfully traverse this ground of rejection, and request, pursuant to 37 C.F.R. §104(d)(2) that the Examiner provide any evidence he may have in support of his assertion, contrary to Applicants' understanding of the meaning of the term in the art, that "high stringency" is either conditional or indefinite.

Applicants believing that the outstanding grounds of rejection have been overcome by amendment or traversed by argument, they respectfully request that the Patent Office withdraw all rejection under 35 U.S.C. §112.

2. Claims 1-4 are novel under 35 U.S.C. §102.

Claims 1-4 stand rejected under 35 U.S.C. §102(b) over the teachings of the Bunzow reference. Applicants understand that the basis for this rejection is that the Examiner was unable to enter their preliminary amendment, reciting their proper claim of priority to U.S. Serial No.

08/474,892, filed June 7, 1995, and U.S. Serial No. 07/973,588; filed November 9, 1992, due to the amendment being in improper form. Applicants have amended their specification pursuant to the currently-acceptable format, and respectfully contend that this application is novel over the cited reference, since recognition of Applicants' priority claim pursuant to 35 U.S.C. §120 removes the reference as prior art. Withdrawal of this ground of rejection is therefore respectfully requested.

Claims 1-4 stand rejected under 35 U.S.C. §102(b) over the teachings of the Wouters reference. Initially, the reference does not disclose the nature or identity of the dopamine-binding species in the microsomal fraction of mammalian brain described in the reference. The Patent Office will recognize from Applicants' specification that mammalian brain contains at least two distinct dopamine receptors, designated D1 and D2. The Patent Office will also recognize that several other dopamine receptor species have been identified in mammalian brain after the priority date of the instant specification and after the publication date of the Wouters reference. Each of the pending claims positively recites the amino acid sequence identity of the claimed dopamine receptors comprising the membrane preparations of the invention; there is no evidence that it is one of these species, rather than the plurality of other dopamine receptor species in mammalian brain, responsible for the dopamine binding activity disclosed in the Wouters reference, nor is there any evidence of record that the microsomal fractions reported by Wouters homogeneously contain just the D2 dopamine receptor species of the claimed invention. Thus, Applicants respectfully submit that the Wouters reference does not anticipate the invention as instantly claimed, and request that this ground of rejection be withdrawn.

CONCLUSIONS

Applicants respectfully contend that all conditions of patentability have been met and that the pending claims are in condition for allowance. Allowance of the pending claims is therefore respectfully solicited.

If the Examiner in charge of this application believes it to be helpful, she is invited to contact the undersigned attorney by telephone at (312) 913-0001.

Respectfully submitted,
McDonnell Boehnen Hulbert & Berghoff

By: 

Kevin E. Noonan, Ph.D.
Reg. No. 35,303

Dated: June 5, 2003



1646

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
(Case No. 90,1092-BBB)

PATENT

In the Application of:

CIVELLI *et al.*

Serial No.: 09/934,358

Filed: August 21, 2001

For: DOPAMINE RECEPTORS
AND GENES

Before the Examiner: **RECEIVED**
J. Ulm

JUN 10 2003

Group Art Unit: 1646 TECH CENTER 1600/2900

Commissioner for Patents
Washington, D.C. 20231

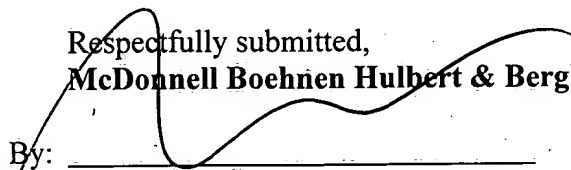
Sir:

TRANSMITTAL LETTER

1. We are transmitting herewith the attached papers for the above-described patent application:
Response to Office Action and return postcard.
2. No additional fees are required.
3. GENERAL AUTHORIZATION TO CHARGE OR CREDIT FEES: Please charge any additional fees or credit any overpayment to Deposit Account No. 13-2490.
4. CERTIFICATE OF MAILING UNDER 37 C.F.R. 1.8: The undersigned hereby certifies that this Transmittal Letter and the papers, as described in paragraph 1 herein above, are being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, Washington D.C. 20231, on June 5, 2003.

Respectfully submitted,
McDonnell Boehnen Hulbert & Berghoff

Dated: June 5, 2003

By: 
Kevin E. Noonan
Reg. No. 35,303